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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,522	02/05/2001	Maria Altamura	205 010	4796

7590

04/14/2004

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/762,522	Applicant(s) ALTAMURA ET AL.	
	Examiner Brenda Coleman	Art Unit 1624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 28 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached Action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 23,24,26,27,30,31 and 35.

Claim(s) rejected: 21,22,25,28,29 and 32-34.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ADVISORY ACTION

Claims 21-35 are pending in the application.

The period for reply continues to run SIX MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

The amendment filed March 29, 2004 under 37 CFR 1.116 in reply to the final rejection has been entered, but is not deemed to place the application in condition for allowance. For purposes of appeal, the status of the claims is as follows:

Allowed claim(s): none

Rejected claim(s): 21, 22, 25, 28, 29 and 32-34

Claim(s) objected to: 23, 24, 26, 27, 30, 31 and 35

This action is in response to applicant's amendment dated March 29, 2004.

Claims 21, 25, 28, 29 and 34 have been amended.

Response to Arguments

Applicant's arguments filed March 29, 2004 have been fully considered with the following effect:

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The applicant's **proposed** amendment to the specification at page 1, lines 22-27 would reinstate two of the new matter rejections from the previous office action, i.e. the differences between Ar₁ and Ar.

b) The amendment to page 1, lines 22-27 of the amendment filed March 2, 2004 has an "and" between the moieties C₁₋₃ alkyloxy and C₂₋₄ amino-alkyloxy, which should not be there, but a comma should. The "and" should be after the CN moiety to indicate the end of the Markush grouping. Additionally, thiophene is spelled wrong. The paragraph should be as shown below (emphasis added):
-(CH₂)_rAr where r is 0, 1 or 2 and Ar is an aromatic group chosen among benzene, naphthalene, thiophene, benzothiophene, pyridine, quinoline, indole, furan, benzofuran, thiazole, benzothiazole, imidazole, benzoimidazole, possibly substituted with up to 2 substituents chosen among C₁₋₃ alkyl, C₁₋₃ haloalkyl, C₁₋₃ alkyloxy, C₂₋₄ amino-alkyloxy, halogen, OH, NH₂, CN, **and** NR₆R₇, where R₆ and R₇, are the same or different, and are H or C₁₋₃ alkyl,

c) The amendment to page 1, lines 29-32 of the amendment filed February 12, 2003 has an "and" between the moieties C₁₋₃ alkyloxy and C₂₋₄ amino-alkyloxy, which should not be there, but a comma should. The "and" should be after the CN moiety to indicate the end of the Markush grouping. Additionally, benzene is spelled wrong. The paragraph should be as shown below (emphasis added):

-(CH₂)_rAr₁ where r is 0, 1 or 2 and Ar₁ is an aromatic group chosen among: ben[e]zene, naphthalene, thiophene, benzothiophene, pyridine, quinoline, indole,

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furan, benzofuran, thiazole, benzothiazole, imidazole, benzoimidazole, possibly substituted with up to 2 groups chosen among: C₁₋₃ alkyl, C₁₋₃ haloalkyl, C₁₋₃ alkyloxy, C₂₋₄ amino-alkyloxy, halogens, OH, NH₂, CN, **and** NR₆R₇, where R₆ and R₇, are the same or different, and are H or C₁₋₃ alkyl;.

In addition to the objections to the specification outlined above, the applicant's proposed amendment to claim 34 is not sufficient to overcome the new matter rejection labeled paragraph 8 in the office action mailed March 15, 2004. The scope of claim 34 is broader than the sub-genus described in the specification.

In view of the non-entry of the amendment filed March 29, 2004, all objections and rejections of the previous office action are herein maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Brenda Coleman".

Brenda Coleman
Primary Examiner Art Unit 1624
April 12, 2004